

REMARKS

Claims 1-14 are pending in this application. Claims 1, 2, 4-6, and 12-14 stand rejected and claims 3 and 7-11 are objected to. Applicant wishes to thank the Examiner for the indication of allowable subject matter in claims 3 and 7-11. By this Amendment, claim 7 has been amended. The amendments made to claim 7 does not alter the scope of this claim, nor has this amendment been made to define over the prior art. Rather, the amendment to the claim has been made to correct a typographical error. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Paragraph 3 of the Office Action rejects claims 1, 5, and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,097,712 (“Secord”) in view of U.S. Patent No. 6,317,412 (“Natali”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Among the limitations of independent claims 1, 5, 12, 13 and 14 not present in the cited reference is a control data generator for generating control data from a frequency difference between a frequency band and the predetermined frequency band.

The Office Action asserts that the control data is generated from a frequency difference as shown by items 42-46 in Figure 4 of Secord where the inputs ω_c and $\Delta\omega$ of 42-46 provide the control data. Additionally, the Office Action asserts that there is inherently a control data generator generating the control data. Applicant respectfully disagrees with this assertion. The control data generator recited in Applicant's claims includes a phase data generator for generating phase data from the frequency difference in synchronization with the predetermined sampling clock, and a converter for converting the phase data to the control data consisting of a plurality of control bits.

In contrast, items 42-46 in Figure 4 are used to baseband the signal as well as other carriers. Secord fails to discuss generating control data based on a frequency difference between the frequency band and the predetermined frequency band. As such, Secord fails to disclose this explicitly recited limitation.

Natali was included not to cure the above-recited deficiency but to disclose an I-Q plane. Whether or not Natali does disclose this is irrelevant as it fails to cure the above-recited limitation. As such, Applicant respectfully asserts that claims 1, 5, 12, 13 and 14 are allowable over the cited references.

Claims 2-4 depend from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Secord (or Natali) and are also believed to be directed towards the patentable subject matter. Thus, claims 2-4 should also be allowed.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: March 31, 2004

Respectfully submitted,

By

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas - 41st Floor
New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant

IRB/mgs